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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,913	09/05/2000	Werner Opitz	H 3266 PCT/US	2582

7590

06/17/2004

Stephen D Harper
Henkel Corporation
Suite 200
2500 Renaissance Blvd
Gulph Mills, PA 19406

EXAMINER

SINES, BRIAN J

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,913

Applicant(s)

OPITZ ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/25/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 15-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 15-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

In view of the appeal brief, filed on 3/25/2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

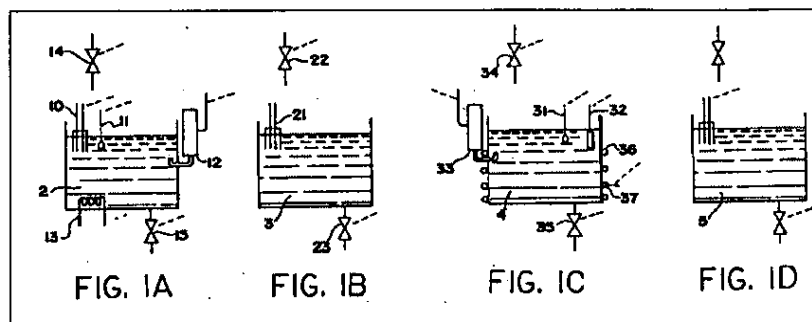
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 20 – 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Tittle (U.S. Pat. No. 4,886,590). Regarding claims 1 and 35, Tittle anticipates the recited method for operating a cleaning bath, wherein the method is comprising the steps of: (a) drawing a sample of specified volume from a cleaning bath; (b) determining the alkalinity of the sample using titration using measuring device (12 & 33); (c) outputting the result of step (b); and adding one or more replenishing components to the cleaning

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bath if the result of step (b) is below a preset value, such as a pH value (see col. 3, lines 14 – 31; col. 4, lines 23 – 56; col. 5, lines 35 – 51; col. 9, lines 19 – 57).



Regarding claims 20 – 24 and 34, Tittle anticipates the use of a computer and including automatic monitoring and control (see col. 4, line 16 – col. 5, line 22). Regarding claims 25 – 28, it is inherently anticipated that the standard solutions utilized in the titration process would be either given or determined before implementing the titration process. Regarding claim 29, Tittle teaches the use of conventional pH-sensitive electrodes (see col. 5, lines 35 – 51). Regarding claims 30 and 31, Tittle teaches the use of conductivity sensors (see col. 4, lines 23 – 42). Regarding claim 32, Tittle teaches the use of liquid level sensors (see col. 4, lines 3 – 15). Regarding claim 33, Tittle teaches that the computer may activate a detectable signal, such as an alarm, during monitoring and control (see col. 4, lines 43 – 63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tittle in view of Rolchigo et al. (U.S. Pat. No. 5,820,690 A).

Regarding claim 15, Tittle does not specifically address the issue of filtering or removing solids from a withdrawn sample prior to the titration step. However, Rolchigo et al. do recognize that the cleaning process can generate solid or aggregate particulate matter (see col. 5, line 25 – col. 6, line 29). It is notoriously well known in the art that such sensing devices may be fouled due to such contaminants in a chemical processing fluid (see MPEP §2144). The applicant is advised that the Courts have held that “[o]bviousness cannot be established by combining the teachings of the prior art to

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produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)). However, the “suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all the references used to show obviousness.” See *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985). Rather, the test is whether the combined teachings of the prior art, taken as a whole, would have rendered the claimed invention obvious to one of ordinary skill in the art. See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The Courts have held that “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 & 1458 (Fed. Cir. 1998) (see MPEP § 2143.01). Furthermore, the Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (see MPEP § 2143.02). A person of ordinary skill in the art would accordingly have had a reasonable expectation of success of incorporating the step of removing solids from the cleaning bath sample prior to the titration step. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the step of removing solids from the cleaning bath sample prior to the titration step in order to prevent sensor or titrator fouling.

Regarding claims 16 – 19, Tittle does teach the use of a titrator in monitoring the cleaning bath. Tittle does not teach specific methods of titration, such as determining free and total alkalinity in determining cleaner activity. Rolchigo et al. does teach the use of titration in determining free and total alkalinity in determining cleaner activity (see col. 10, lines 11 – 26). Each of the recited titration techniques disclosed by Tittle and Rolchigo et al. are considered functionally equivalent (see MPEP § 2144.06). The Courts have held that an express suggestion to substitute one equivalent component or process for another is not necessary to render such a substitution obvious. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Furthermore, the Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (see MPEP § 2143.02). Consequently, a person of ordinary skill in the art would accordingly have had a reasonable expectation of success of incorporating the teachings of titration as taught by Rolchigo et al. for operating cleaning bath, with the apparatus and method of Tittle. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the titration techniques for monitoring cleaning baths, as taught by Rolchigo et al., with the apparatus and method disclosed by Tittle in order to provide for an effective monitoring process.

Response to Arguments

Applicant's arguments with respect to claims 1 and 15 – 35 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rossman et al. teach a process for cleaning solid surfaces with aqueous alkaline cleaning solutions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700